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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/901,114 | 07/10/2001 | Takashi Furuta | 1046.1257 | 7213 |

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| EXAMINER |
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WU, RUTAO

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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|------------------------|--|---------------------|--|
| Office Action Summary | Application No. | | Applicant(s) | |
| | 09/901,114 | | FURUTA ET AL. | |
| | Examiner | | Art Unit | |
| | Rutao Wu | | 3639 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. A claim limited to a machine or manufacture which has practical application in the technological arts is statutory. In most cases, a claim to a specific machine or manufacture will have practical application in the technological arts. See MPEP 2106, 2100-14 (quoting *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557). Additionally, for subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V.*

Diehr, 450 U.S. at 192, 209 USPQ at 10). For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970).

In the present case, claims 8-13 only recite an abstract idea. The recited steps of merely storing target money and service information and performing a mathematical analysis to determine the amount of shared money allocated to each service does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to calculate the amount of money each service receive in a revenue sharing system.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. An invention, which is eligible or patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452 and *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). The test for practical application as applied by the examiner involves the determination of the following factors"

- (a) "Useful" – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with

the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, the claimed invention collects service usage information and fees (i.e., repeatable) used in determining the amount of shared money allocated to each service provider (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 8-13 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 8, 10, 15, 17 and 25-27 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6,131,085 to Rossides.

Referring to claims 1, 8 and 15:

A profit sharing system for an agency service, comprising:

A storage module storing amounts of share target money, which should be shared to a plurality of providers, of profits obtained by operating for a predetermined period an agency service for providing users with a plurality of services provided from a plurality of providers; (col 234: lines 31-32) and

A calculation module calculating an amount of shared money allocated to each service from within the amount of shared target money stored in the storage module on

the basis of a frequency of providing each service during the predetermined period. (col 12: lines 15-21)

Referring to claims 3, 10 and 17:

A profit sharing system according to claim 1, wherein the profits are a total of agency service usage fees during the predetermined period that are collected from the users on the basis of one single contract. (col 234: lines 31-32)

Referring to claim 25:

A profit sharing system for an agency service, comprising:

A providing module providing an agency service for providing a user with a requested service among services provided by a plurality of providers; (col 14: lines 15-16) and

A calculation module calculating an amount of shared money, shared to each provider, or profits obtained by providing the agency service on the basis of a frequency of providing the user with the service. (col 12: lines 15-17)

Referring to claims 26-27:

A profit sharing method in an information processing system, for an agency service, including a storage module and a control unit, said method comprising:

Making said control unit provide the agency service for providing a user with a requested service among services provided from a plurality of providers; (col 14: lines 15-16)

Storing said storage module with a providing count of providing the service to the user; and (col 10: lines 57-58).

Calculating an amount of shared money, shared to each provider, of profits obtained by the agency service on the basis of a providing frequency of each service that is obtained from the providing count of each service and a total sum of service providing counts. (col 12: lines 15-17)

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 2, 4, 6-7, 9, 11, 13-14, 16, 18, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 6,131,085 to Rossides.

As per claims 2, 9 and 16, Rossides discloses a function that tallies the number of requests for the service (col 10 lines 57-58; col 13: lines 22-24).

Rossides also discloses that it calculates the frequency of demand by taking the number of times the data has been requested over the time period. Then it calculates the payoff by multiplying the frequency with the royalty rate (col 12: lines 15-21).

Rossides further states that the pay off formula can be infinitely variable (col 12: line 36). Therefore it would be obvious to one skilled in the arts to modify the above formula to calculate the frequency of usage by taking the quotient of usage per service divided by the total number of usage, then calculate the amount of shared money by multiply the frequency of usage by the amount of available shared money.

As per claims 4, 11 and 18, Rossides does not explicitly disclose the method of calculating shared money from profit. However, the examiner takes official notice that calculating revenue by subtracting operating cost from profits was well known at the time of applicant's invention. It is a method well known to one skilled in the arts.

As per claims 6, 13 and 20, Rossides discloses that his AC is a database that allows a plurality of users provide answers or raw data to a plurality of questions (col 10: lines 5-11).

Rossides discloses that a user inputs a question causing the AC to search for the corresponding answer. If the answer is found, the answer is outputted (col 9: line 66). The AC also tallies data-request and data uses (col 10: lines 57-58).

As per claims 7, 14 and 21, Rossides does not disclose that it provides the user with a list of dictionary contents corresponding to a search key received from the user, and provides the user with the dictionary content selected from this list by the user. Rossides discloses that a user inputs a question causing the AC to search for the corresponding answer. If the answer is found, the answer is outputted (col 9: lines 62-66; col 13: lines 34-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a database with dictionary content from a plurality of providers. Rossides provides specific motivation by indicating that AC can be adapted to collect a variety of answers (col 9: line 3) and can include many other useful sets of steps (functions) (col 14: lines 12-13).

As per claims 22-24, Rossides discloses that AC can enable a user to designate given search stats as optional or mandatory. This means that the mandatory conditions

Art Unit: 3639

are preferably matched over the optional ones (col 44: lines 7-10). Thereby setting a priority to mandatory search stats.

3. Claims 5, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossides in view of U.S. Pat No. 5,893,903 to Eisdorfer et al.

Rossides does not disclose a step of requesting a financial institution to pay the shared money to each provider.

Eisdorfer discloses in his patent that clearinghouse2 sends back a stamp modified to include its identity for clearinghouse1 authentication. Clearinghouse1 will then send payment to clearinghouse2 according to the predetermined revenue allocation arrangement (col 4: lines 41-44). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rossides' invention to allow requesting a financial institution or a clearinghouse for the payment of the shared money. One would be motivated to perform such modification to be certain that the service providers receive payment for services provided.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to revenue sharing in general:

U.S. Pat No. 5,359,508 to Rossides.

U.S. Pat No. 5,657,222 to Randolph.

U.S. Pat No. 6,751,475 to Holmes et al.

U.S. Pat No. 6,760,916 to Holtz et al.

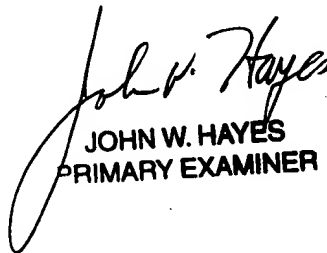
U.S. Pub No. 20010039497 to Hubbard.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136. The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw


JOHN W. HAYES
PRIMARY EXAMINER